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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,433	04/20/2001	Claude Jarkac Jensen	10209.56	1737

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/07/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/839,433

Applicant(s)

JENSEN ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 8, 11, 12, 22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-8, 11-12, 22, and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Receipt of Amendment D received on September 22, 2003 is acknowledged. Claims 1, 7-8, 11-12, 22, and 27 are pending in this application. Claims 2-6, 9-10, 13-21, and 23-30 have been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7-8, 11-12, 22, and 27 are under 35 U.S.C. 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998-2003) in view of Pelle et al (6,136,301).

Tahitian Noni teaches noni products and teaches the noni juice to deliver soothing and renewing benefits to the skin. The reference teaches the use of the oil contains linoleic acid and essential fatty acids to nourish the skin and dry spots (Note Tahitian Noni essential oil). The reference teaches an SPF lip balm containing noni oil. Lastly, the reference teaches the combination of the juice and oil in Tahitian Noni Skin Supplement and Body Balance Cream.

The reference does specify percentages in the topical formulation.

Pelle et al teach a natural lip product for repairing chapped, cracked lips (col. 1, lines 10-25). Pelle teaches the use of free fatty acids (5-40%) such as oleic and palmitic acid since these are the primary naturally occurring free fatty acids in the stratum

Art Unit: 1616

corneum (col. 3, lines 40-56). A wax base "known in the art" is formulated from waxes and oils. Waxes such as beeswax, ozokerite or paraffin and plant or animal oils are taught in the amount of 1-20% (col. 4, lines 38-41). Sunscreens such as zinc oxide are taught. See column 5, line 1. Pelle teaches the use of active agents such as anti-irritants in the composition (col. 5, line 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tahitian Noni Products and Pelle et al. One would be motivated to look at the teachings of Pelle since Pelle et al provide the general guidance in formulating a moisturizing lip product. Pelle teaches using natural oils containing essential fatty acids in the instant amount and Tahitian Noni teaches noni is heals, soothes, and nourishes the skin and the oil contains fatty acids such as oleic and palmitic acids. Therefore one would expect similar results since both references teach moisturizing lip formulations with essential fatty acids.

Although the Noni products fail to disclose the amount of the morinda citrifolia juice and oil, the mere difference in concentration as the sole criteria for patentability for subject matter encompassed by the prior art is not supported in the absence of unexpected data. See MPEP 2144.05.

Response to Arguments

Applicant argues that the Noni-Now website was not activated until April 29, 2002 and cannot be used as prior art.

Applicant's arguments have been fully considered but they are not persuasive. Noni-Now that indicates the lip-product was available to the market in 1999.

Furthermore, according to the website the company was established in 1996 and provides the sales figures. Therefore, even if the website was not available to the public, the product was available to the public and therefore constitutes prior art.

Claims 1 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonte et al (5, 676, 949) in view of Wadsworth et al (WO 01/15537) in further view of Fisher (Living Better, vol. 1 (5)).

Bonte et al teach a cosmetic or pharmaceutical product for dermatological conditions. The composition is used to treat skin disorders such as hyperpigmentation, vitiligo, psoriasis, restoring/preserving the skin, and increasing moisture (col. 1, lines 15-30). The composition contains .001-5% of a mulberry extract (examples and col. 3, lines 27-30).

Bonte does not teach specify the type of mulberry extract.

Wadsworth et al teaches morinda citrifolia oil, which can be used in cosmetics (col. 3, line 42). The reference discloses that morinda citrifolia is an essential oil that contains several different fatty acids (col. 3, lines 35-55 and Table 1).

Fisher teaches that French Polynesian used the juice for various ailments such as skin problems (abscesses, abrasions, wounds, infections, and boils).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use morinda citrifolia oil and juice in Bonte's cosmetic composition with the expectation of similar results since Bonte's teaches a generic mulberry extract. One would be motivated to use morinda citrifolia is that Wadsworth teaches the instant oil contains essential fatty acids, known for their conditioning

Art Unit: 1616

properties and Fisher teaches the use of the instant plant extracts for its wound healing properties. Therefore, the instant mulberry extract would satisfy Bonte's functional properties such as treating skin disorders and increasing moisture in the skin. Further it is prima facie obvious to combine each of which is taught by the prior art to be useful for the same purpose, to form a third composition for the very same purpose.

*Note that the preamble does not hold patentable weight unless a structural limitation is recited.

Response to Arguments

Applicant argues that Bonte fails to specify or suggest the instant mulberry extract or suggest the use of other mulberry extracts.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points to column 3, line 17 and example 7 where one embodiment contains a generic mulberry extract. Therefore one would be motivated to look to WO Wadsworth and incorporate the instant mulberry extract into the Bonte to obtain inventive formulation. The purpose of the simba mulberry extract is to heal skin eruptions and moisturize the skin. One would expect similar results by adding WO's mulberry extract since WO teaches the instant mulberry extract contains essential fatty acids known for their conditioning properties.

Further, Fisher is relied upon to teach the use of noni juice for the same functional purpose as Bonte. As pointed out by the examiner in the rejection, it is prima facie obvious to combine two compositions of which is taught for the same purpose to form a third composition for the same purpose absent unexpected data. See In re

Kerkhoven. In the instant case, Bonte teaches a cosmetic for the skin to heal skin eruptions of various origins and Fisher teaches the use of noni juice for skin ailments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

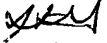
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

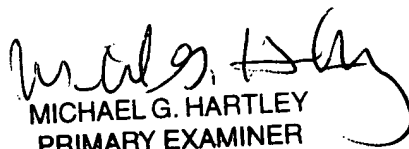
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/839,433
Art Unit: 1616

Page 7

Sharmila Gollamudi


November 3, 2003


MICHAEL G. HARTLEY
PRIMARY EXAMINER